

REMARKS

Applicant hereby responds with traverse to the election or restriction requirement set forth in the Office Action mailed October 7, 2004. Applicant requests reconsideration of the restriction requirement, for the purpose of either (i) obtaining agreement from the Office to reduce the number of invention groupings from thirteen (13) inventions to four (4) inventions, or (ii) placing the above-captioned application in condition to have the restriction requirement made final, to enable applicant to file a prompt petition contesting said restriction requirement.

Applicant submits that restriction of the present application into thirteen (13) different groups of claims is improper because there is commonality among dominant elements in many of the claims, such that there is no serious burden under M.P.E.P. § 803 for the Examiner to examine all elected claims of the invention, as discussed below.

According to M.P.E.P. § 803.01, it is important that restrictions be closely scrutinized to ensure that the public is properly being protected. Applicant has paid \$2,404 in non-refundable filing fees, in an application in which a single invention is defined in Groups I, IV, V, VI, VII, VIII, and IX as outlined in the October 7, 2004 Office Action, such that claims 1-43 and 75-184 merit examination in a single application. To require otherwise would be an unfair and burdensome misuse of

applicant's substantial non-refundable filing fees, for the reasons below under Section III.

I. RESTRICTION OF CLAIMS:

Applicant submits that the Restriction/Election should be modified as detailed herein, since the claims outlined below are sufficiently similar to merit examination in the same application. Applicant submits that the claims may be properly restricted into four (4) groups of claims instead of the thirteen (13) groups of claims enumerated in the October 7, 2004 Office Action. Applicant submits that the Restriction/Election should be modified in the following manner: (i) Invention 1 includes Groups I, IV, V, VI, VII, VIII, and IX as outlined in the October 7, 2004 Office Action; (ii) Invention 2 includes Groups II and XI as outlined in the October 7, 2004 Office Action; (iii) Invention 3 includes Groups III, XII, and XIII as outlined in the October 7, 2004 Office Action; and (iv) Invention 4 includes Group X as outlined in the October 7, 2004 Office Action.

II. ELECTION:

In order to be responsive to the election or restriction requirement set forth in the Office Action mailed October 7, 2004, applicant hereby elects, with traverse, Invention 1 as modified herein, including the claims of Groups I, IV, V, VI, VII, VIII, and IX as outlined in the October 7, 2004 Office Action, namely claims

1-43 and 75-184. Applicant respectfully submits that the foregoing election is a bona fide provisional election of a single invention for the reasons below, and is therefore fully responsive and not in conflict with 37 C.F.R. § 1.143 and M.P.E.P. § 818.03(a). In view of the careful reasoning below, the foregoing election is also not a "mere broad allegation that the requirement is in error" as prohibited by M.P.E.P. § 818.

In the alternative, if the Office deems applicant's election in the paragraph above as nonresponsive, applicant respectfully requests the Office to contact the undersigned or the undersigned's associate Terrence Edwards, to discuss the need for a provisional election with traverse.

III. SPECIFIC ERRORS IN THE RESTRICTION/ELECTION REQUIREMENT:

The claims in Invention 1 as outlined herein above by applicant are not properly restricted as combinations and subcombinations, process and apparatus, or even as unrelated inventions as indicated by the October 7, 2004 Office Action because the claims are directed to the same invention, with each claim having a different scope than the others. In other words, the claims of Invention 1 as modified herein are sufficiently similar to merit examination in the same application.

The Restriction/Election requirement in the October 7, 2004 Office Action classified the independent claims of the above-captioned application in the following manner:

- 1) Group I, claims 1-43 and 92-108, drawn to a fixation device, classified in class 606, subclass 73;
- 2) Group II, claims 44-60, drawn to a fixation device, classified in class 606, subclass 104;
- 3) Group III, claims 61-74, drawn to a fixation device, classified in class 606, subclass 86;
- 4) Group IV, claims 75-91, drawn to a fixation device, classified in class 606, subclass 60;
- 5) Group V, claims 109-126, drawn to a fixation device, classified in class 606, subclass 61;
- 6) Group VI, claims 127-143, drawn to a fixation device, classified in class 606, subclass 72;
- 7) Group VII, claims 144-159, drawn to a fixation device, classified in class 606, subclass 59;
- 8) Group VIII, claims 160-174, drawn to a method, classified in class 623, subclass 16.11;
- 9) Group IX, claims 175-184, drawn to a method, classified in class 606, subclass 99;
- 10) Group X, claim 185, drawn to a method, classified in class 606, subclass 53;

- 11) Group XI, claim 186, drawn to a method, classified in class 128, subclass 898;
- 12) Group XII, claims 187-189, drawn to a method, classified in class 606, subclass 72; and
- 13) Group XIII, claim 190, drawn to a method, classified in class 606, subclass 61.

With respect to Invention 1 as modified herein, which includes Groups I, IV, V, VI, VII, VIII, and IX as outlined in the October 7, 2004 Office Action, all of the elected claims therein should be properly classified in class 606, subclass 60, contrary to the Office's assertions. Subclass 60 is defined in the Manual of Classification as: "Internal fixation means: This subclass is indented under subclass 53. Subject matter wherein a means is adapted to be implanted within the body in direct contact with a bone or bone fragment for the purpose of reinforcement of said bone or bone fragment during the healing process or for positioning a plurality of bones or bone fragments relative to one another."

Each of the claimed features in independent claims 1, 27, 75, 109, 127, 144, 160 and 175 are drawn to subject matter principally based on a means adapted to be implanted within the body in direct contact with a bone or bones. Each of the independent claims listed above is principally directed to an internal fixation device to be attached to bone segments. Thus, applicant submits that each of the claims in Invention 1, as modified herein, are properly

classified in class 606, subclass 60, and modification of the restriction requirement is respectfully requested in accordance therewith.

Further, in view of the facts, the similarities among the claims identified and their common dominant elements, it would appear disingenuous to classify only one of the Groups I, IV, V, VI, VII, VIII, and IX into class 606, subclass 60, without also classifying the rest of those groups into class 606, subclass 60. However, applicant cooperatively acknowledges that the claims of Groups II, III, X, XI, XII and XIII may be properly restricted, as they are not directed principally to an internal fixation device to be attached to bone segments, but are rather directed to a different combination of elements for patentability. Declaring Groups I, IV, V, VI, VII, VIII, and IX to be separate inventions would appear to be financially self-serving of the Patent Office, not only in view of the foregoing facts, but also in view of the \$2,404 in non-refundable filing fees applicant has provided to the Patent Office.

The Office has classified Groups I, IV, V, VI, VII, and IX in class 606. The Office has further classified Group I (claims 1-43 and 92-108) in subclass 73; Group IV (claims 75-91) in subclass 60; Group V (claims 109-126) in subclass 61; Group VI (127-143) in subclass 72; Group VII (144-159) in subclass 59; and Group IX (175-184) in subclass 99. The Office further classified Group VIII

(claims 160-174) in class 623, subclass 16.11. Applicant submits that such subclassification is improper. Independent claims 1, 27 and 92, the independent claims from the Examiner's Group I, claim similar features as independent claims 75 (Group IV), 109 (Group V), 127 (Group VI) and 144 (Group VII). Each of those claims should rightfully be classified in the same class and subclass, which applicant submits should be class 606, subclass 60, since the features claimed therein are similar, but are of varying scope. Further, claims 160 and 175 are method claims that correspond with the apparatus claims 1, 27, 75, 92, 109, 127 and 144, such that those claims could also be examined by the Office without posing a serious burden under M.P.E.P. § 803 on the Examiner. Therefore, applicant submits that independent claims 1, 27, 75, 92, 109, 127, 144, 160 and 175, and their dependencies, should rightfully be examined together, and the same is respectfully requested.

Further, applicant submits that the claim language in each of the claims has been defined sufficiently in the detailed description of the application for the Office to identify the elements being claimed. After such a consideration, applicant submits that the Office will conclude that applicant is claiming the same invention with each claim having a different scope. Therefore, applicant submits that independent claims 1, 27, 75, 92, 109, 127, 144, 160 and 175, and their dependencies, should

rightfully be examined together, and the same is respectfully requested.

Applicant respectfully submits that Invention 1 as modified herein, namely claims 1-43 and 75-184, though different in scope, are nonetheless sufficiently similar to merit examination in the same application, as they share dominant elements. Examination of the claims of Invention 1, i.e., 1-43 and 75-184, in the same application would not pose a serious burden under M.P.E.P. § 803 because there is commonality of dominant elements between the claims of Invention 1.

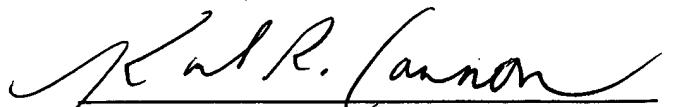
In a balance of the equities, the burden and cost to applicant of prosecuting thirteen (13) separate applications to inventions having common dominant elements appears to outweigh the burden on the Examiner to search and examine the claims of Invention 1 in the present application as a unitary invention. Applicant therefore respectfully requests that the election or restriction requirement be modified as outlined herein and elects examination of Invention 1 as detailed herein.

In view of the foregoing, applicant believes that claims 1-43 and 75-184 are all allowable and the same is respectfully requested. If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated during a telephone interview, the Examiner is invited to initiate the same.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0836.

DATED this 8 day of November, 2004.

Respectfully submitted,



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